

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 22 has been canceled.

Applicant respectfully requests entry and consideration of the claim amendments presented above. Applicant submits that the cancellation of claim 22 is permitted under 37 C.F.R. § 1.116(b)(1). Claim 1 has been amended to incorporate the subject matter of claim 22, which depended from claim 1, and claim 36 has been amended to be placed in independent form. Applicant submits that these amendments present the claims in better form for consideration on appeal per 37 C.F.R. § 1.116(b)(2).

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-21, 23, and 25-37 are now pending in this application.

### **Rejections under 35 U.S.C. § 103**

Claims 1-19, 21-23, and 25-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,810,804 (hereafter “Nyui”) in view of U.S. Patent No. 6,305,801 (hereafter “Kerns, Jr. et al.”). This rejection is respectfully traversed.

Amended claim 1 recites an optical device, comprising a housing, the housing comprising a light source emitting light along an illuminating beam having a two-dimensional cross-sectional area; a main objective; and a spectral filter positioned between the light source and the main objective, wherein the spectral filter is adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam;

wherein the optical device is a surgical microscope. Claim 26 also recites a surgical microscope.

Nyui discloses a retinal camera that includes an observation light source 6, a photographing light source 8, a filter 20, a ring-shaped slit aperture 10, a mirror 11, a relay lens 12, a mirror with an opening 14, and an objective lens 13. See Nyui at col. 2, line 65, to col. 3, line 45. As shown in Figure 1 of Nyui, the ring-shaped slit aperture 10 and mirror with an opening 14 provide an annular-shaped illumination beam to a subject's eye 4 and retina 5. An image of the subject's retina 5 is reflected back through the opening in the mirror 14 to a photographing optical system 3. Therefore, the retinal camera of Nyui is arranged to provide an annular illumination beam so that light reflected from a subject's retina can be observed and photographed. Furthermore, as noted by the Office on page 5 of the Office Action, Nyui does not disclose or suggest a surgical microscope.

Kerns, Jr. et al. discloses a contact lens with an optical filter region that reduces the percentage of light transmitted. See Kerns, Jr. et al. at col. 1, line 56, to col. 2, line 14. Kerns, Jr. et al. discloses that the filter region can attenuate light of different wavelengths by different percentages. See Kerns, Jr. et al. at col. 2, lines 15-32. However, Kerns, Jr. et al. does not disclose or suggest that the contact lens can be used in a surgical microscope.

It would not have been obvious to one of ordinary skill in the art to combine the teachings of Nyui and Kerns, Jr. et al. to provide the devices of claims 1 and 26. A basic requirement of a *prima facie* case of obviousness is that a prior art reference, or prior art references when combined, must teach or suggest all of the claim limitations. See M.P.E.P. §§ 2143, 2143.03. The Office has not set forth a *prima facie* case of obviousness because Nyui and Kerns, Jr. et al., alone or in combination, fail to disclose or suggest all of the features of claims 1 and 26.

The Office appears to take Official Notice in regard to the features of claims 1 and 26. The Office states on page 5 of the Office Action that surgical microscopes are known and are comparable to Nyui. However, the Office has not cited any prior art which teaches that contact lens techniques can be applied to surgical microscopes or that techniques from retinal cameras with annular illumination beams can be applied to surgical microscopes.

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nyui in view of Kerns, Jr. et al., and further in view of U.S. 6,271,968 (hereafter “Dobrowolski et al.”). This rejection is respectfully traversed. Dobrowolski et al. fails to remedy the deficiencies of Nyui and Kerns, Jr. et al. discussed above in regard to independent claim 1, from which claim 20 depends. Withdrawal of this rejection is respectfully requested.

Claims 36 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nyui in view of Kerns, Jr. et al., as applied to claims 1 and 26, and further in view of U.S. Patent No. 5,442,487 (hereafter “Mizuno”). This rejection is respectfully traversed.

Amended claim 36 recites an optical device, comprising: a housing, the housing comprising a light source emitting light along an illuminating beam having a two-dimensional cross-sectional area; a main objective; and a spectral filter positioned between the light source and the main objective, wherein the spectral filter is adapted to reduce, without eliminating, the intensity of the light emitted by the light source in a specific region, the specific region being a subsection of the two-dimensional cross-sectional area of the illuminating beam; wherein at least a portion of a central region of the light emitted by the light source is incident on the main objective. Claim 37 recites similar language.

As noted by the Office on page 6 of the Office Action, Nyui and Kerns, Jr. et al. do not disclose or suggest a device “wherein at least a portion of a central region of the light emitted by the light source is incident on the main objective.”

Mizuno discloses an ophthalmic photocoagulating device that includes laser diodes 41 that emit a beam at a wavelength of 800 nm, an aiming laser 50 that emits a beam at a wavelength of 633 nm, and a dichroic mirror 70 that perfectly reflects a wavelength of 800 nm and reflects 50% of visible rays. See Mizuno at col. 4, line 65, to col. 5, line 3; col. 5, lines 28-32, 46-48. Therefore, the device of Mizuno is configured to perfectly reflect a central portion of a beam emitted by laser diodes 41 and at least 50% of a central region of a beam emitted by laser 50. Mizuno teaches that the optics of the device focuses the beams of aiming laser 50 and the laser diodes 41 into circular spots and that an operator can observe the spot formed by aiming laser 50 because some of the light reflected from a subject’s eye 74 is transmitted through the objective lens 71 and dichroic mirror 70. See Mizuno at col. 5, line

38, to col. 6, line 17. Applicant notes that the objective lens 71 shown in Figure 6 is flat on its left side and that the beam reflected from a subject's eye 74 (represented by the dashed line) passes through the objective lens 71 to the dichroic mirror 70 without being diffused, thereby providing a focused, circular spot for an operator's observation. Mizuno further discloses an illumination system 80 that provides light to a subject's eye through a mirror 81 with an opening. See Mizuno at col. 6, lines 18-22.

One of ordinary skill in the art would understand that the illumination system 80 is similar to the system of Nyui in that a central portion of a beam emitted by the illumination system 80 is not incident on a main objective because a beam from the illumination system 80 is reflected by mirror 81 with an opening. Therefore, the combination of the illumination system 80 of Mizuno with the system of Nyui and Kerns, Jr. et al. would not provide all of the features of claims 36 and 37. (The other beams in Mizuno are for aiming and photocoagulation.)

For at least the reasons discussed above, withdrawal of this rejection is respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

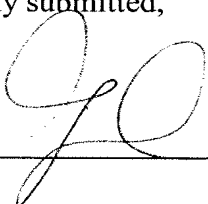
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 2/1/07

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